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In re Application of	:	
DOLLY, et al.	:	DECISION ON PETITION
U.S. Application No.: 10/049,967	:	
PCT No.: PCT/GB00/03196	:	UNDER 37 CFR 1.47(a)
Int. Filing Date: 18 August 2000	:	
Priority Date: 20 August 1999	:	
Attorney Docket No.: 20020065.ORI	:	
For: ISOFORMS OF SNARE MOLECULES AND	:	
THE USES THEREOF IN MODULATION OF	:	
CELLULAR EXOCYTOSIS	:	

This decision is in response to applicant's "Petition Under 37 CFR 1.47(a)" filed 11 October 2002 in the United States Patent and Trademark Office (USPTO).

BACKGROUND

On 18 August 2000, applicant filed international application PCT/GB00/03196, which claimed priority of an earlier application filed 20 August 1999. A copy of the International Application was forwarded to the United States Patent and Trademark Office (USPTO) from the International Bureau (IB) on 15 March 2001. A Demand for international preliminary examination, in which the United States was elected, was filed on 19 March 2001, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 20 February 2002.

On 18 February 2002, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1) and First Preliminary Amendment. Applicant did not file an executed oath or declaration of the inventors.

On 25 April 2002, applicant was mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) informing applicant of the need to provide an executed oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date as well as payment of the \$130.00 surcharge for providing an executed oath or declaration later than thirty months from the earliest claimed priority date. Applicant was

given two months to respond and advised that this time period could be extended with a proper petition and payment of fees.

On 11 October 2002, applicant responded with the present petition to accept the present oath or declaration without the signatures of inventors James O. DOLLY, Nadiem MOHAMMED and Patrick G. FORAN accompanied by a check in the amount of \$1570.00 (\$1440.00 as payment of the four-month extension of time fee and \$130.00 as payment of the petition fee); a petition for a four-month extension of time, and a combined declaration and power of attorney executed by inventor Gregory A. O'SULLIVAN. With the filing of the petition for a four-month extension of time, applicant's petition is considered to be timely filed.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(I), (2) factual proof that the missing joint investor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

As to Items (1), applicant has provided the required petition fee of \$130.00.

Regarding Item (3), the petition states the last known addresses of the non-signing inventors: James O. DOLLY, Nadiem MOHAMMED and Patrick G. FORAN.

As to Item (4), accompanying the petition is a declaration signed by the remaining inventor on his behalf, and on behalf of the non-signing inventors. Accordingly, Items (1), (3) and (4) have been satisfied.

As to item (2), Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP) states, in part:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47. Such a petition will be dismissed as inappropriate.

The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that

the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

A review of the present petition and the accompanying papers reveals that applicant has not satisfied item (2) above, in that the applicant has not shown that a bona fide attempt was made to present the application papers, including the specification, claims, and drawings to inventors James O. DOLLY, Nadiem MOHAMMED and Patrick G. FORAN. The excerpt of the letter from Dr. Pilkington seems to indicate that the inventors were merely provided copies of the declarations. Was a complete copy of the application papers (specification, including claims, drawings, and oath or declaration) mailed to the missing inventors? Additionally, the only first hand knowledge that counsel can provide is that he sent a copy of the declaration, power of attorney and petition to the firm of Eric Potter Clarkson. This is insufficient.

In order to meet the requirements of 37 CFR 1.47(a) and Section 409.03(d) of the MPEP, a statement of facts is needed from a person having first hand knowledge of the facts that a complete copy of the application papers was sent to James O. DOLLY, Nadiem MOHAMMED and Patrick G. FORAN, and when such papers were sent. In addition, copies of documentary evidence such as a certified mail return receipt, cover letter of instruction, telegrams, etc., should be supplied with the declaration. As to the alleged refusals of the inventors MOHAMMED AND FORAN, applicant needs to provide an executed statement from an individual with first hand knowledge of the 20 September 2002 meeting with inventors MOHAMMED AND FORAN. As to inventor DOLLY, it appears from applicant's papers that inventor is willing to execute the declaration after it has been signed by the other inventors although this information is also second hand.

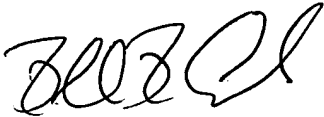
For the reasons stated above, it would not be appropriate to accept the application without the signatures of James O. DOLLY, Nadiem MOHAMMED and Patrick G. FORAN under 37 CFR 1.47(a) at this time.

CONCLUSION

Applicant's petition under 37 CFR 1.47(a) is **DISMISSED, without prejudice**.

Applicants are hereby afforded **TWO (2) MONTHS** from the mail date of this decision to file either 1) an oath or declaration in compliance with 37 CFR 1.497 (a)-(b) signed by all inventors or 2) a renewed petition satisfying all requirements under 37 CFR 1.47(a). Any reconsideration request should include a cover letter entitled, "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be directed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter directed to the attention of the PCT Legal Office.



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